

## **REMARKS**

Claims 4 and 19 are cancelled without prejudice or disclaimer. Claims 2 and 22 were previously cancelled without prejudice or disclaimer. Therefore, claims 1, 3, 5-18, 20, 21, and 23-27 are the claims presently pending in the Application.

Claims 3 and 9 are amended so as to clarify features recited thereby. This amendment introduces no impermissible new matter. Claims 5 and 20 are amended such that they depend from non-cancelled claims.

### ***Rejection of Claims 1, 3-13, 15-20 and 23-37 under 35 U.S.C. § 102(e)***

Claims 1, 3-13, 15-20 and 23-37 are rejected under 35 U.S.C. § 102(e) as being anticipated by Mölne. This rejection is traversed.

Claims 4 and 19 are cancelled, thus the rejection is moot as to these claims.

Among the problems recognized and solved by Applicant's claimed invention is that of selecting a new network for a handover during a communication session based on a preference for a network stored by user equipment. According to an aspect of Applicant's claimed invention, to facilitate a handover neighbor cell information for the other network is provided to the user equipment via the active network, or a list of available other networks is provided to the user equipment via the active network.

For at least the following reasons, Applicant's claimed invention is neither anticipated by, nor rendered obvious from, the cited art, including Mölne. By way of

example, independent claims 1, 3, 11, 25 and 26 require providing via the active network neighbor cell information for the preferred other network to the User Equipment. Further independent claims 6, 16, 18 and 23 require, *inter alia*, providing to user equipment via the active network a list of available other networks. Moreover, independent claims 7, 8 and 24 require, *inter alia*, providing to the user equipment via the active network a message for incrementally adding to or subtracting from a list of available networks.

Mölne discloses a mobile telephone with a subscriber identify module (SIN) which provides a roaming selection list to identify and to prioritize network operators to which the mobile telephone can be connected (Mölne, Abstract). Further, Mölne discloses that the mobile telephone has a list of preferred roaming selection networks to which the mobile preferably connects when roaming (Mölne, col. 2, line 66-col. 3 line 33); that the preferred roaming selection list can be updated using the mobile telephone or by an operator over the air (Mölne, col. 3, line 46-49); and, that the mobile telephone uses the preferred roaming selection list to determine which of a plurality of different networks that are broadcasting in the mobile telephone current geographical area should be selected for connection at power up of the mobile unit for cell selection, or for cell reselection when the mobile telephone is roaming between cells belonging to different networks (Mölne, col. 3, lines 21-28). With respect to the selection by the mobile station, Mölne discloses that the mobile station searches for control channels having the identification codes stored in the SIN in the order of their priority on the preferred roaming selection list, and in this way connecting with the highest ranked network on the list (Mölne, col. 3, lines 28-32).

Thus, while Mölne discloses that the mobile station can use the preferred roaming selection list that it stores to assist it in selecting a different network while roaming, Mölne does not disclose or suggest that the presently active network with which the mobile telephone is in communication assists the mobile telephone in a handoff by providing information about other networks. Clearly, Mölne does not disclose or suggest that the presently active network with which the mobile telephone is in communication provides to the mobile telephone neighboring cell information for the preferred other network or a list of available other networks.

Therefore, Mölne does not disclose or suggest providing neighbor cell information for the preferred other network to the user equipment via the active network, as *inter alia* required by claims 1, 3, 11, 25 and 26. Nor does Mölne disclose or suggest providing to user equipment of via the active network a list of available other networks, as *inter alia*, required by independent claims 6, 16, 18 and 23. Moreover, Mölne does not disclose or suggest providing to the User Equipment via the active network a message for incrementally adding to or subtracting from a list of available networks as *inter alia* required by independent claims 7, 8 and 24.

Claims 13 and 15 depend from independent claim 1; claim 5 depends from independent claim 3; claim 10 depends from claim 9; claim 12 depends from independent claim 11; claim 17 depends from independent claim 16, claim 20 depends from independent claim 18, and claim 27 depends from independent claim 26. Therefore claims 5, 10, 12, 13, 15, 17, 20 and 27 incorporate novel and the non-obvious features of their respective base claims and are patentably distinguishable over the prior art for at

least the reasons that there respective base claims are patentably distinguishable over the prior art.

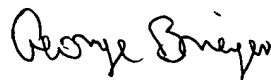
***Rejection of Claims 14 and 21 under 35 U.S.C. §103***

Claims 14 and 21 are rejected under 35 U.S.C. § 103 as being obvious from Mölne. This rejection is traversed.

Claim 14 depends from claim 1, and claim 21 depends from claim 16. Therefore, claims 14 and 21 are patentably distinguishable over the prior art, including Mölne, for at least the reasons that their respective base claims are patentably distinguishable over the prior art.

In view of the foregoing discussion, the Application is now believed to be allowable and the Examiner is respectfully requested to reconsider the rejections and allow the Application. Should the Examiner have any questions about the within Amendment, or about the Application more generally, the Examiner is invited to telephone the undersigned attorney at the telephone number listed below.

Respectfully submitted,



George Brieger  
Registration No. 52,652

Scully, Scott, Murphy & Presser  
400 Garden City Plaza  
Garden City, New York 11530  
(516) 742-4343 Ext. 503

GB:eg